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IN THE

Supreme Court of the United States

October Term, 1944.

No. 469.

SPECIAL EQUIPMENT COMPANY,

Petitioner,

vs.

CONWAY P. COE, Commissioner of Patents,

Respondent.

BRIEF FOR PETITIONER.

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CONWAY P. COE, Commissioner of Patents,

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BRIEF FOR PETITIONER.

There was a dismissal, by the District Court, without opinion. The opinion of the Court of Appeals for the District of Columbia (R. 142) is reported at 144 F. (2d) 497.

Jurisdiction.

Writ of certiorari issued to the Court of Appeals for the District of Columbia, to review its decision, rendered June 19, 1944.

It was granted on the showing, (a) that in a suit under Section 4915 of the Revised Statutes * (35 U.S.C.A. 63,

* See Appendix to this Brief.

pursuant to Sections 24 and 128 of the Judicial Code as amended), the court denied patent claims on the ground that there was lack of intention on the part of the owner to use the claimed structure *alone*, which it held constituted a misuse, notwithstanding the record admittedly established, and the court found, extensive use, by the petitioner, of the claimed structure with an additional feature, and that the claimed machine was successfully operated without the additional feature, and (b) that the lower court thus decided an important federal question in direct conflict with the Constitution, the statutes and the well established applicable decisions of this and other courts.

Statement of the Case.

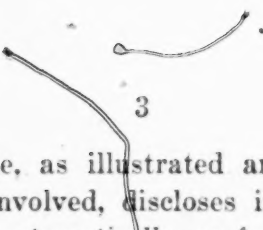
Ewald, an independent inventor, conceived and disclosed an automatic machine, for use in preparing pears for canning. On October 6, 1932 he duly filed an application (R. 28-109) for patent thereon, in full compliance with the law in such cases made and provided.

Prior thereto, in order to make available to the consuming public, in this and other countries, the enormous harvest of pears, canning had been resorted to for many decades.

It is important that they first be properly prepared, that is, split, bobbed, peeled and cored.

Prior to Ewald's invention all these operations were done generally *by hand*, that is, there would be one group of workers splitting, another group bobbing (slicing off the small end), another group peeling and another group coring (R. 16).

Ewald, an independent businessman, had, for many years, prior to 1932 (R. 15), such a canning plant, at a small town in the far northwest, employing these hand operations, where he struggled along with the old hand operations, as did the other pear canning plants in general.



Ewald's machine, as illustrated and described in his application here involved, discloses instrumentalities for *mechanically and automatically performing each of these operations.*

Among the objects, as stated at the outset of his application (R. 28), is "the provision of mechanical means for increasing the speed with which pears may be prepared for canning."

So far as his main invention is here concerned, Ewald's application shows *, two spaced horizontally mounted turrets or turn tables, combined with means for continuously, but intermittently, rotating both in the same direction. Fixed to and rotatable with the first are a plurality of pear receiving and clamping means, spaced around the turn table, adapted to receive and clamp either pre-split or whole pears.

An attendant *manually* places a pear in each pear holding and clamping means as they move past his station. Thereafter, the pear is immediately clamped and held in position, as initially placed.

At the first intermittent stop, a swinging knife shears off the stem end of the fruit which extends beyond the clamp, thus removing the stem. This is known as bobbing.

At the next intermittent stop, spaced overhead traveling jaws or clamps grasp the fruit, concurrently with the release of the first clamp, and carry the fruit longitudinally to a point over the second turret or turn table, where the pear sections are deposited in cups, fixed on the *second* turn table. At the next stop on the *second* turn table the pear section is peeled, by an automatically operated paring knife. During the next successive stop, the core is removed from the pear section, by an automatically operated coring device, which upon completing the coring, inverts the pear section so as to deposit the core in the cup with the peeling.

* See "Illustrative Drawing Embodying Ewald Invention", at end of this brief.

This briefly indicates the main invention on which petitioner is here seeking patent claims, denied by the lower court.

The automatic machine thus far mentioned has been, and is extensively used, with an additional feature. It was successfully operated alone, without such feature, for bobbing, peeling and coring pears, when the attendant fed pre-split pears, and demonstrated a "tremendous advance" over the prior art, as shown by the evidence (R. 18-23 and motion picture Plaintiff's Exhibit 6), and as found by the lower court (R. 148).

If whole pears are fed by the attendant to the pear holding and clamping devices on the first turret, then the pear is thereafter split as it is carried by the overhead clamping jaws, from the first turret to a position over the second turret.

Splitting is there caused by a fixed vertically positioned knife, straddled by the spaced overhead traveling clamps. As this clamp forces the pear past the knife, the knife cleaves the pear into substantially equal half sections. Such a knife is shown in the application here involved. It was used in petitioner's commercial machines.

Ewald's invention has *revolutionized* the pear canning industry as shown by the evidence (R. 14-17) and found by the lower court (R. 142).

These machines were made by Ewald's company, of which he was manager and president, in his home town in the state of Washington (R. 15).

Since 1931, it has increased the annual production of canned pears from around 3,000,000 cases to over 6,000,000 cases (R. 16), with half the labor (R. 17), and has cut the cost *to the ultimate consumer* about one-half, for example, from thirty to fifteen cents a can (R. 17). Further, the canned pears are very much more palatable and salable, for when hand peeled, ridges resulted from the peeling

knife, because a woman peels from end to end and around, while with the Ewald machine, the paring knife makes one sweeping cut just inside the skin, producing a very nice appearing half fruit (R. 17). About eighty per cent of all pears canned are prepared by Ewald's machine (R. 142).

The evidence (R. 18-23) and the motion picture film (Plaintiff's Exhibit 6) show beyond question, that the Ewald machine here involved can and was successfully used and operated *sans splitting knife*, when feeding pre-split pears. When so fed, all the remaining features of his automatic machine functioned and operated in exactly the same way, and accomplished the same result, as when the splitting knife was present (R. 20). The lower court found from the evidence (R. 148) that the Ewald machine *sans splitting knife* "represented a tremendous advance" and in operation would result in a great saving of manpower, of time and of working space, and that the record "makes these facts apparent beyond question." (R. 148)

No patent has yet issued on the invention claimed in this application, but claims have been found allowable by the patent office which include the splitting knife.

The definite additional claims (R. 5-7), referred to as sub-combination claims, directed to Ewald's main invention and novel machine for bobbing, peeling and coring, which do not include the splitting knife, were duly presented to the Patent Office, in the same application, and rejected.

Suit was duly brought in the District Court of Columbia, under Section 4915 of the Revised Statutes, by the independent businessman, Mark Ewald, as plaintiff, on May 21, 1941, against the Commissioner of Patents, asking for a decree (a) adjudging that he was entitled to receive a patent including those claims, and (b) directing their allowance (R. 2-7).

Claims 38, 39, 41 and 44 (R. 5-7) were there sought, and are here involved. None mention the splitting knife. Claim 38 may be taken as typical. It reads:

38. An automatic machine for preparing pears comprising a rotary turret having a plurality of pear holding means, bobbing means operable in succession upon the pears on said holding means for severing the necks of the pears transversely to the stem axes thereof, transfer mechanism cooperable with said turret for transferring the bobbed pears from the turret, a second turret including additional spaced holding means cooperable with the transfer mechanism to receive the pears from the transfer mechanism, means for moving said second turret and its holding means in synchronism with the first-mentioned turret and its holding means, paring and coring mechanism operatively associated with the path of movement of said additional holding means and mechanism for actuating said transfer mechanism and said paring and coring mechanism in timed relation to said turrets.

An answer was filed on June 6, 1941 on behalf of the defendant. It was not until January 26, 1943 that Ewald's company was substituted as plaintiff (R. 13-14).

The Commissioner of Patents admitted allegations 3 to 9, inclusive, and 12 of the bill. The answer alleged *no prior art against allowance of the claims*, but raised the same technical objections as the patent office tribunals did, to the effect that the claims did not cover a proper subcombination, that they were not complete, that they were broader than the invention disclosed, and that they were misleading and covered constructions not contemplated by Ewald. The answer made no reference to lack of intention to use.

When Ewald originally filed his application he presented at the outset, as number one (R. 80), a subcombination claim which did *not* include a splitting knife. This was done by

Ewald himself, under oath, as a part of his original application filed on October 6, 1932, nine years before this controversy arose.

The District Court, without opinion, signed findings of fact (R. 9-10) to the effect that the subcombination claims, themselves, did not "combine to produce any useful result" and "were incomplete and failed to point out" or "properly define" plaintiff's invention as required by Section 4888* of the Revised Statutes, the same grounds relied on by the Patent Office tribunals in denying the claims. Each such ground was overruled by the Court of Appeals (R. 148), for it found, the claims, in controversy, were typical subcombination claims; that there was no lack of completeness or clarity; that they specifically pointed out what was claimed, as an invention, and it would not be difficult to construct the subcombination from the drawings; that the suggestion that the subcombination is inoperative when the pear is pre-split before feeding to the machine is directly contrary to the evidence, particularly to the incontrovertible evidence of the motion picture displayed to the court; and that considering the terms of the older practices in pear canning the Ewald machine without the inclusion of the splitting knife, namely, the subcombination machine standing alone, represented a tremendous advance and an operation which would result in great saving of manpower and of time (R. 148), thus overruling the grounds on which the claims were denied by the district court and the patent office. However, notwithstanding no prior art was set up or urged to anticipate or vitiate the patentable novelty of these subcombination claims, it held that the claims should not be granted solely because it concluded there was lack of intention to use these claims *without the splitting knife*, although it found and held that this invention, covered by the

* See Appendix.

subcombination claims, was extensively used with a splitting knife and that its successful operation, without the splitting knife, was demonstrated (R. 18-23, 148).

No reference was made concerning lack of intention to use in any of the pleadings, briefs or arguments, either in the Patent Office, the district, or appellate courts.

There is no evidence in the record to show or establish lack of intention to use. The petition for rehearing in the lower court (R. 155) makes this clear.

Ewald's original Claim 1 (R. 80), presented by Ewald himself, did *not* include a splitting knife. The petition for rehearing in the lower court (R. 156) shows that it is petitioner's present and future intention to so use, whenever and wherever deemed advisable, direct or through licensees. Further, the uncontradicted evidence shows that when Ewald first started using his machine, it was tried out with pre-split pears. Skog, petitioner's superintendent, on cross examination was asked (R. 23):

"When did you first try out the machine (Ewald's here involved) with pre-split pears?"

and he answered:

"The original machine that Mr. Ewald started to devise was started that way."

And, the appellate court said, speaking through Associate Justice Miller (R. 148):

"The notion that the inventor (Ewald) must have thought only in terms of splitting as an intermediate process, ignores the long history of pear canning as a hand process and the inescapable fact that one who was experimenting in this area must have tried a variety of arrangements until he found the one most adapted to his purpose."

**Specification of Errors Intended
to Be Argued.**

1. The decision of the lower court is in direct conflict with and contrary to the Constitution and the patent statutes enacted pursuant thereto and the uniform decisions of this and all other United States courts.

2. The lower court erred in denying patent claims in a proceeding under Section 4915 solely because the court concluded there was lack of intention to use, grounds never before recognized by any court, notwithstanding the record admittedly shows the extensive use of the claimed invention in commercial machines, with a splitting knife, and its successful use without a knife was demonstrated.

3. The lower court erred in holding that patent claims should be denied, unless there is a showing, that the applicant, or his assigns, intend to use the claimed structure alone.

4. The lower court erred in creating and applying a new bar—lack of intention to use—to the grant of a patent claim, contrary to all prior decisions of this and other courts, which rule, if adopted, would substantially impair our patent system, *the basis of our industrial civilization*.

5. The lower court erred in holding that a patentee may not obtain in one patent, claims on his main invention as well as on his entire combination and on such parts of the combination as are new and useful.

6. Lack of intention to use is not a misuse, and, therefore, no grounds for denying a patent.

7. There is no lack of intention to use the main invention. On the contrary, the evidence clearly establishes that the main invention was extensively used commercially. If lack of intention to use the main invention, without a knife, is a bar, then the lower court erred in not giving the petitioner his day in court on such issue, and in concluding

there was lack of intention to use the main invention *sans* knife, without evidence to establish such fact, particularly when the petition for rehearing in the lower court shows that it is the intention of petitioner to use the main invention alone, or to grant licenses to others so to do.

Question Before This Court.

The question, which involves the construction of the Constitution and the patent laws enacted pursuant thereto, is:

Whether, as the Court of Appeals for the District of Columbia held, a patentable claim, proper as to form, embracing patentable novelty, admittedly covering a mechanical invention of tremendous value and extensively used commercially with an additional feature, should be refused solely because the court concluded there was *lack of intention* by the owner to use the claimed structure *alone*. More briefly stated, whether lack of intention to use a sub-combination *per se* is a misuse and, therefore, a bar to the grant of a patent claim, upon a mechanical device otherwise admittedly patentable and allowable, and also whether lack of intention to commercially use the claimed structure *per se* is a misuse and, therefore, a bar, when the record admittedly shows that the inventor or his assigns have extensively and commercially used the claimed structure, with an additional feature, and demonstrated successful operation and use without the additional feature, and where the owner contends that it is its intention to commercially use the claimed structure *per se* when thought advisable.

ARGUMENT.

I.

Discussion on Fundamentals of Patent System—Basis of Our Industrial Civilization.

It would seem that the lower court clearly misapprehended the fundamentals of our patent system and the law here applicable, as well as certain facts in this case.

The Constitution, which forms the basis for our American way of life, very wisely provides the foundation for our *industrial civilization*. In Article I, Section 8, it says, "Congress shall have the power . . . To promote the progress of Science and the useful Arts by securing for limited times to Authors and Inventors, the *exclusive* Right to their respective Writings and Discoveries." Pursuant to that authority, Congress has made provisions for granting patents to inventors for limited times.

Section 4884 R.S.* provides for the "grant to the patentee, his heirs or assigns, for the term of seventeen years, of the *exclusive* right to make, use and vend the invention."

According to the dictionaries, "exclusive" means excluding or right to *exclude*.

This and other courts have repeatedly and consistently held that a patent *only gives* the inventor and his successors or assigns the right to *exclude* others from using his claimed invention.

Neither the Constitution nor the Statutes, as interpreted by this and other courts, give the right to actually use the claimed invention. This is obvious, for the claimed invention might incorporate structures and features covered by prior existing patents.

Indeed, in this and other courts, in most of the cases where the patent has been held valid and infringed, the

* See Appendix.

defendant owned a patent on his *particular* infringing structure.

It is not necessary to manufacture, sell or use the invention, in order to promote the progress of science and the useful arts. When the patent actually issues, the invention is *revealed* to science and the art to which it relates. This published revelation is then available to science and the useful arts.

The framers of our Constitution apparently full well realized that the development of our industrial civilization depended largely on inventors, and that our government must do something to induce inventors to make and reveal their inventions.

An invention is not something created by the government, or something in the public domain, or something that belongs to the public. It is not taken away from the public or the government, but is non-existent until made by the inventor.

The makers of our Constitution obviously realized all these things. Congress, acting on constitutional authority, has, by appropriate enactments, said, in effect, to all inventors, whether citizen or foreigner:

Mr. Inventor, we realize that you have or will or can make inventions of importance which will promote science and the useful arts and form the basis of our industrial civilization. Therefore, if you will file your revelation in the Patent Office within the time and in the manner provided, we will grant you the right to *exclude* others from making, selling, or using your respective inventions for a limited period, but at the expiration of such period you no longer will have the right to *exclude*, as your invention will then go into the public domain. There are no conditions which require you *actually* to use. We do not give you any right *actually* to use, because your claimed invention might utilize the invention of some prior existing patent. If

it does, then you must obtain permission to use the prior existing patented invention, or proceed to make, sell, or use at your peril.

Every patent issued since the establishment of our Patent Office necessarily issues on such conditions and understanding.

Our patent system is "the basis upon which our entire industrial civilization rests." *

"The patent system added the fuel of interest to the fire of genius." (President Lincoln.)

II.

Discussion on Facts and Statement of Law.

For decades, prior to the advent of Ewald's invention, in the canning factories, pears were prepared for canning by hand, as heretofore pointed out. Ewald, an independent businessman, operated such a pear canning plant, for many years, at Olympia, a small town in the state of Washington (R. 15).

Notwithstanding, there were many objections to the hand method, recognized by all, and there was a long existing pressing need for a solution of the problem, Ewald, an independent inventor, alone conceived the invention which adequately solved the long perplexing problem.

Apparently the big corporations in the canning machinery industry, with their large technological departments and technologists, were unable to solve the problem, but all waited for Ewald, the independent inventor.

Ewald's solution took the form of an automatic machine *almost human in operation*, for it automatically and mechanically bobs, peels, and cores the pears in a far more satis-

* Report of the National Patent Planning Commission appointed in 1941 by executive order of the President. (Journal of the Patent Office Society, Volume 25, No. 7, page 456).

factory manner than by the old method and one which can run on either whole or pre-split pears with the halves face to face.

Ewald, the independent businessman, started about 1931 to manufacture at Olympia, Washington, pear canning machines embodying his invention and continuously since has supplied them to the canning industry, generally, while the large manufacturers in the industry, with all their regimented technologists, looked on with covetous eyes.

The ultimate *consuming public* received and enjoyed the benefit of Ewald's invention, as it was responsible for reducing the cost of canned pears to the consumer from thirty to fifteen cents per can and providing a more palatable product (R. 17).

Pre-splitting pears in canning factories was old and well known before Ewald. As patents are addressed to those skilled in the art, anyone skilled in the art would know that, either whole or *pre-split*, pears could be fed to Ewald's generic machine, and that in the latter event the knife could be *entirely omitted*. "That which is common and well known is as if it were written out in the patent and delineated in the drawings." (*Loom Company v. Higgins*, 105 U. S. 580 at 585). However, when feeding whole pears, the manner in which Ewald's machines were extensively operated, there was also provided in the machine a vertically positioned sharp blade which split the pears during the transfer from one turret to the other.

When feeding pre-split pears, the blade, being unnecessary, was removed. In such case the machine operated with satisfactory results and the parts of the machine operated in exactly the same manner and accomplished the same results as when whole pears were fed (R. 20), and when considered in terms of the older practices in pear canning "represented a tremendous advance, and in operation would result in great saving of manpower, of time, and of working space" (R. 148).

Ewald fully illustrated and described his machine and the preferred way of using. As to feeding he says (R. 41): "The fruit" is "placed within the fruit cup at station A." He doesn't say that it must be a whole fruit or whether it is whole fruit or pre-split. In his drawings he indicates in dotted lines the contour of the fruit. However, the contour would be precisely the same whether whole or pre-split pears were used. It is wholly immaterial that he did not say in words, in his specification, that the machine was adapted to run on pre-split fruit. The law does that for him, because it is well established that in considering a machine, the applicant or patentee is entitled to all its uses or ways of using. There can be no doubt, we submit, that the Ewald machine is *inherently* adapted for running on pre-split pears as well as whole pears. In addition, the evidence unquestionably shows that it could be and was successfully operated when run on pre-split pears, and the lower court so found.

This court has repeatedly held that a patentee is entitled to all the *uses* and advantages which are inherent in his machine, certainly since its decision in *Stow v. Chicago*, 104 U. S. 547 (opinion by Mr. Justice Woods), where the court said at page 550:

"A patentee who is the first to make an invention is entitled to his claim for all the uses and advantages which belong to it."

In *Potts v. Creager*, 155 U. S. 597, this court (opinion by Mr. Justice Brown) said at page 606:

"Doubtless a patentee is entitled to every use of which his invention is susceptible, whether such use be known or unknown to him."

There are several inventions disclosed in Ewald's application, and under the law he is clearly entitled to claims covering each invention. Even Justice Arnold's opinion

says (R. 143): “* * * it seems more plausible to say that the subcombination does produce a useful result and that two distinct inventions are disclosed in the application.”

“Claims are independent invention” (*Leeds & Catlin v. Victor Talking Machine Co.* (No. 1), 213 U. S. 301, at page 319, which “may be united (in one patent), if two or more relate to a like subject, or are in their nature or operation connected together” (*U. S. ex rel. Steinmetz v. Allen*, 192 U. S. 543, at page 558) and “in that event he (the patentee) can secure, the full benefit of the exclusive right to each of the several inventions by separate claims” in the same patent (*Gill v. Wells*, 22 Wall. 1, at page 24).

When Ewald conceived his invention, it was not something that belonged to the public or the government. It had no existence theretofore. It was something intellectually created by him. He was under no obligation to make a revelation to anyone. Had he kept it secretly to himself, then the fact that he conceived the invention would not promote science and the useful arts in any way whatsoever. Instead of choosing to keep it a secret, he accepted the government's proposition and disclosed and claimed his invention in the manner prescribed by Congress, and on the condition that by so doing, our government would give him claims on his invention, affording him the right to *exclude* others from using his claimed invention for a limited number of years.

Ewald is here insisting that he is entitled to the allowance of claims covering his generic or *main invention* which do not include the splitting knife.

Notwithstanding, (a) that the grounds relied on by the district court and the patent office were overruled; (b) that there was no prior art against these additional claims to anticipate or invalidate them, or negative invention; and (c) that they were extensively used commercially as shown by the evidence and found by the court, the lower court

denied these additional claims covering the main invention, on lack of intention to use, this revolutionary generic combination *alone*, without the splitting knife.

The structures set forth in most of the patent claims sustained by this and other courts for decades were not capable of use *alone*, but were used *only* with additional means not described in the patents sustained.

The evidence in this case *not before the Patent Office* admittedly proved, beyond question, that the knife was unnecessary, when pre-split pears were fed to the machine. The undisputed testimony of the witness Skog, superintendent for petitioner, shows that the original machine, Mr. Ewald started to devise, was tried out with pre-split pears. Ewald, under oath, when he filed his original application, initially presented as Claim 1 (R. 80) a combination claim which did *not* include the splitting knife. Therefore the statement (R. 152) in the lower court's opinion that sub-combination claims which did not include the knife were not filed by the inventor, but first presented by the assignee seeking to enlarge the invention is contrary to and without support in the record. But even if so, presentation by the assignee is immaterial for Ewald himself was the *manager and president* of his small company, to which his application was assigned (R. 15).

The petition for rehearing in the lower court shows that the lower court's conclusion as to lack of intention to use must have been based on a misapprehension of a statement made in the brief of petitioner's counsel that "the claims in issue are sought purely to prevent appropriation of the Ewald machine by the obvious expedient of eliminating the splitting mechanism," but that is a far cry from saying—if it were material—that petitioner had no intention of using its machine, without the splitting knife, when feeding pre-split pears.

Counsel was only saying there what the law says for the inventor, that is, he is entitled to a patent properly protecting his *main* invention. That is the purpose of every patent; that is the purpose of the statute based on the Constitution.

Moreover, the petition for rehearing says that the petitioner "reserves the right to use, or license others so to do, when he so desires, his important invention for bobbing, peeling and coring pears either when the pears are pre-split by hand or split in the machine."

There is no evidence whatever in this case that Ewald, if granted the claims sought, will misuse the patent. Therefore, it seems reasonable to assume that it will be properly used until the *contrary is adequately proven*.

We believe it is well established in *this country* that one is presumed to be innocent until proven guilty.

Under this court's decisions, misuse would merely be a ground for refusing to give relief in a court of equity, not for refusing to issue a patent. Moreover, it is clear that the patent would be enforceable after the misconduct terminated and its effects dissipated.

In none of the cases relied on in the lower court's opinion did the court hold that mere lack of intention to use constituted a *misuse* or *misconduct*. Any such holding would be directly contrary to the fundamentals of our patent system.

The theory on which the lower court denied relief is a point not raised by the government and not argued or briefed by either side. If the new barrier created by the lower court, of lack of intention to use, has any application at all, it would certainly seem that it would not apply in denying a patent claim before granting the patent and before anyone *actually knows as a matter of fact* just what use, or rather *misuse*, will be made of the patented

combination *per se* after issuance. It would be high time to consider such a defensive point after the patent has issued and after misuse has been clearly established by proper evidence.

It is well and uniformly established by this and other courts throughout the land: (a) that an applicant is entitled to receive in one and the same patent, claims not only on the entire combination, but (Section 4888 R. S.) on such "part, improvement or combination" as is patentably novel; (b) that the subcombinations and parts thereof so claimed need not be useful or *even operative alone or by themselves*; (c) that a patent does not grant the right to actually make, sell or use, but only to *exclude; that non-use, even when intentional, is not a bar to a valid patent claim*; (d) that a patent claim does not take anything away from the public which it already possessed; and (e) that an inventor is entitled to all that his patent fairly covers, even though its complete capacity is not recited in the specification and was unknown to the inventor prior to issuing the patent.

We now direct the court's attention to the law applicable.

LAW APPLICABLE.

Patents Do Not Grant the Right to Actually Make, Sell or Use, But Only to EXCLUDE Others from Making, Selling or Using the Claimed Invention.

This court (opinion by Chief Justice Stone) said in March, 1940 in *Ethyl Gasoline Corp. v. United States*, 309 U. S. 436, at page 456:

"The patent law confers on the patentee * * *, the right or power to exclude all others from manufacturing, using, or selling his invention. R. S. Sec. 4884, 35 U. S. C., Sec. 40."

In *United States v. Winslow*, 227 U. S. 202, at page 217 the Court (opinion by Mr. Justice Holmes) said:

“The machines are patented, * * * the exclusion of competitors from using them is of the very essence of the right conferred by the patents, *Paper Bag Patent Case*, 210 U. S. 405.”

In *United Shoe Machinery Corp. et al. v. United States*, 258 U. S. 451, this court, (opinion by Mr. Justice Day) said, at page 463:

“From an early day it has been held by this court that the franchise secured by a patent consists only in the right to exclude others from making, using, or vending the thing patented without the permission of the patentee. *Bloomer v. McQuewan*, 14 How. 539. This definition of the rights of the patentee has been the subject of frequent recent decisions of this court, and has been approved and applied” (citing cases).

See also: *Motion Picture Patents Co. v. Universal Film Mfg. Co. et al.*, 243 U. S. 502; *Bauer & Cie. v. O'Donnell*, 229 U. S. 1.

In *Herman v. Youngstown Car Mfg. Co.*, 191 Fed. 579, the Court of Appeals for the Sixth Circuit, speaking through the late Circuit Judge Dennison, said, page 584:

“A patent is not the grant of a right to make or use or sell. It does not, directly or indirectly, imply any such right. It grants only the right to *exclude* (italics ours) others. The supposition that a right to make is created by the patent grant is obviously inconsistent with the established distinctions between generic and specific patents, and with the well-known fact that a very considerable portion of the patents granted are in a field covered by a former relatively generic or basic patent, are tributary to such earlier patent, and cannot be practiced unless by license thereunder.”

In *United States v. Sanitary Mfg. Co.*, 191 Fed. 172, (Goff and Pritchard, Circuit Judges, and Rose, District Judge), the court, speaking through District Judge Rose, said, at page 190:

“A patent is a grant of a right to exclude all others from making, using, or selling the invention covered by it.”

See also *Bird's Eye Veneer Co. v. Franck-Philipson & Co.*, 259 Fed. 266, 269 (C. C. A. 6); *Swindell v. Youngstown Sheet & Tube Co.*, 230 Fed. 438 (C. C. A. 6).

Indeed, a line of decisions to the same effect, by this and other courts, could be cited to an extent quite unnecessary here, for example see:

Carbice Corp. v. Am. Patents Corp., 283 U. S. 27, 31 (1931); *Continental Paper Bag Company v. Eastern Paper Bag Company*, 210 U. S. 405, 423-426; *United States v. Bell Telephone Company*, 167 U. S. 224, 239; *Belknap v. Schild*, 161 U. S. 10, 15, 16; *Bloomer v. McQuewan*, 14 How. 539, 549; *Chemical Foundation, Inc. v. General Aniline Works, Inc.*, 99 F. (2d) 276, C. C. A. 3; *Waterbury Buckle Co. v. G. E. Prentice Mfg. Co.*, 294 F. 930; *Talbot v. Quaker-State Oil Refining Co.*, 104 F. (2d) 967, 968, C. C. A. 3.

This well established rule, that a patent is merely the right to *exclude*, is sound and based on reasoning. In fact, in nearly every patent suit where the courts have found infringement, the defendant had a patent on his particular form, held to infringe, but this and other courts hold that infringement is not avoided, by making additions or improvements, nor because the defendant has a patent therefor: (*Herman v. Youngstown Car Mfg. Co.*, 191 Fed. 579, 584 (C. C. A. 6); *Hobbs v. Beach*, 180 U. S. 383, 401; *Columbia Wire Co. v. Kokomo S. & W. Co.*, 143 Fed. 116, 124 (C. C. A. 7); *Ries, et al. v. Barth Mfg. Co.*, 136 Fed. 850, 853 (C. C. A. 7); *Ryder, et al. v. Schlichter*, 126 Fed. 487 (C. C. A. 3).

Lack of Use, Even When Intended, Is Not a Bar to Relief Under a Patent.

In the *Paper Bag Patent Case*, 210 U. S. 405, this court (opinion by Mr. Justice McKenna) held that an inventor receives from a patent the right to *exclude* others from its use for the time prescribed under the statutes and that such right *was not dependent on his using the device or affected by his non-use thereof*. In that case no use whatever was made of the claimed invention either *per se* or with other things and the *non-use was intentional*. In answering the argument of counsel there, similar to the contentions made by the Court of Appeals, in the present case, that competitors would be excluded from the use of the claimed structure, this Court said, at page 429:

“We answer that such exclusion may be said to have been of the very essence of the right conferred by the patent, as it is the privilege of any owner of property to use or not to use it, without question of motive.”

In the *Paper Bag Case*, the Liddell patent there involved was owned by a financially strong manufacturing company, engaged in manufacturing paper bags. It related to a machine for manufacturing paper bags. Plaintiff also owned an earlier patent on a paper bag making machine, which it was engaged in making and using commercially. Therefore, it deliberately and intentionally, declined to use or grant any rights to others to use the Liddell machine throughout the life of the Liddell patent. The owner of the Liddell patent brought suit in *equity* against an infringer, who strenuously urged, that because of this intentional non-use for such a long period of time, an injunction should be denied. This court, in dealing with the question so strenuously urged, commencing on page 424, *reiterated the well established rule* and quoted from its previous decisions in *United States v. Bell Telephone Com-*

pany, 167 U. S. 224, 249; *Grant v. Raymond*, 6 Pet. 220; *Bloomer v. McQuewan*, 14 How. 539, 549; *Patterson v. Kentucky*, 97 U. S. 501, to the effect that the right which a patentee receives from the government under his patent is the right to *exclude* (p. 425):

“If he (a patentee) sees fit, he may reserve to himself the exclusive use of the invention or discovery. If he will neither use his device nor permit others to use it, he has but suppressed his own. * * * His title is exclusive, and so clearly within the constitutional provisions in respect of private property that he is neither bound to use his discovery himself nor permit others to use it.”

On considering, defendant's serious contention, that the owner of the Liddell patent, because of his intentional non-use, was not entitled to an *injunction*, the court said (p. 429):

“We have seen that it has been the judgment of Congress from the beginning that the sciences and the useful arts could be best advanced by giving an exclusive right to an inventor. The only qualification ever made was against aliens in the act of 1832. That act extended the privilege of the patent law to aliens, but required them ‘to introduce into public use in the United States the invention or improvement within one year from issuing thereof,’ and indulged no intermission of the public use for any period longer than six months. A violation of the law rendered the patent void. The act was repealed in 1836. It is manifest, as is said in Walker on Patents, Section 106, that Congress has not ‘overlooked the subject of non-user of patented inventions.’ And another fact may be mentioned. In some foreign countries the right granted to an inventor is affected by non-use. This policy, we must assume, Congress has not been ignorant of nor of its effects. It has, nevertheless, selected another

policy; it has continued that policy through many years. We may assume that experience has demonstrated its wisdom and beneficial effect upon the arts and sciences.”

The court concluded by holding that intentional non-use is not sufficient grounds to even defeat an *injunction in a court of equity*.

The decision of this court in the *Paper Bag Case*, that deliberate intentional non-use, is not a defense to the validity of a patent, or even to the granting of an injunction thereunder, in a court of equity, has been approved by this court, in a number of subsequent cases. (See for example: *Henry v. A. B. Dick Co.* 224 U. S. 1, 29, 52 (1911); *Bauer & Cie v. O'Donnell*, 229 U. S. 1, 10 (1912); *Motion Picture Patents Co. v. Universal Film Co.*, 243 U. S. 502, 510, 519 (1916); *United States v. United Shoe Mach. Co.*, 247 U. S. 32, 58 (1917); *Woodbridge v. United States*, 263 U. S. 50, 55 (1923); *Long v. Rockwood*, 277 U. S. 142, 147, 149 (1928); *Fox Film Corp. v. Doyal*, 286 U. S. 123, 127 (1931) *United States v. Dubilier Condenser Corp.*, 289 U. S. 178, 186).

Therefore, we say that under the Constitution and Statutes as interpreted by this court, a patent does not give any right to manufacture, to sell, or to use, but only the right to *exclude*. Lack of intention to use the structure of a subcombination claim, if established, is not a bar to the grant of a patent claim when it is not even a bar to an injunction in a court of equity.

Why should an inventor's property right, which Webster said, during his famous argument in the *Goodyear Rubber Case*, “existed before the Constitution, above the Constitution, and is a natural right more clear than that a man can assert in almost any other kind of property”* be denied, even though, there may exist lack of intention to use?

* The Writings and Speeches of Daniel Webster, Vol. 15, p. 438.

A Patentee Is Entitled to Claims to a Subcombination Even If That Subcombination Is Not Useful in or of Itself or Without the Addition of Other Means Not Set Forth in the Claims.

Deering v. Winona Harvester Works, 155 U. S. 286, 302 (1894); *Loom Company v. Higgins*, 105 U. S. 580; *Brammer v. Schroeder*, 106 F. 918, C. C. A. 8; *Parham v. American Buttonhole, Overseaming & Sewing-Machine Co.*, Fed. Case. 10,713, 18 Fed. Cas. 1096; *Clark Blade & Razor Co. v. Gillette Safety Razor Co.*, 194 F. 421, C. C. A. 3; *Canda et al v. Michigan Malleable Iron Co.*, 124 F. 486, C. C. A. 6; *Otis Elevator Co. v. Pacific Finance Corp.*, 71 F. (2d) 641, C. C. A. 9 Cert. den. 293 U. S. 593; *Mississippi Valley Trust Co. v. Bussey*, 49 F. (2d) 881, C. C. A. 5; *Firestone Tire & Rubber Co. v. United States Rubber Co.*, 79 F. (2d) 948, C. C. A. 6; *In re Caunt*, 81 F. (2d) 405, C. C. P. A.; *Johnson Co. Inc. v. Philad Co. et al.*, 96 F. (2d) 442, C. C. A. 9.

Claims for the Main Invention and Claims for Subcombinations or Parts Thereof Are Allowable and Should Be Allowed in the Same Patent.

This court held, in *Philadelphia, Wilmington and Baltimore R. R. Co. v. John DuBois*, 12 Wall. 47, 79 U. S. 265, that a patentee may obtain in one and the same patent, claims on the entire combination and also claims for such parts of the combination as are new and useful. That rule has always obtained and still obtains in this Court, in the Patent Office and in the federal courts, throughout the land, without any known recorded exception.

From the inception of the Patent system, this Court and all other courts have held valid and infringed patents, which contained claims on the entire combination and on parts of the combination.

Robinson on Patents, Volume 2, page 143, Sec. 528, a recognized authority, says:

“The specification of a combination may contain several different Claims. Besides the Claims for the combination as a whole, each of its elements and subcombinations, if new and patentable inventions, may be also claimed, even where they are useless except as portions of the principal invention.” Citing cases.

Walker on Patents, Deller Edition, Vol. II, Sec. 166, page 789, says:

“A part or a combination may be claimed separately, though it cannot do useful work separately from the residue of the machine or apparatus of which it constitutes a part.” (Citing a long line of cases in the Supreme and other courts.)

Continuing, Walker says:

“Otherwise an infringer might take the most important part of an invention, and by changing the method of adapting it to its environment, might avoid any charge of infringement.”

Walker also says, in the same edition, on page 1232:

“A claim may cover the entire process, machine, manufacture, or composition of matter which is set forth in the description, or it may cover such parts or such sub-processes, or such combinations, as are new and useful inventions; and the specification may contain a claim for the whole, and other claims for separate parts, and still other claims for separate sub-processes or combinations.” (Citing several decisions in this and other courts.)

See also:

Leeds and Catlin Company v. Victor Talking Machine Company, 213 U. S. 301; *United States ex rel. Steinmetz v. Allen*, 192 U. S. 543, 558, 559; *Miller v. Eagle Mfg. Co.*,

151 U. S. 186; *Dobson v. Hartford Carpet Company*, 114 U. S. 439, 446; *Clements v. Odorless Apparatus Co.*, 109 U. S. 641, 649; *Parks v. Booth*, 102 U. S. 96; *Mathews v. Machine Co.*, 105 U. S. 54; *Brown v. Guild*, 23 Wall. 181; *Gill v. Wells*, 22 Wall. 1; *Philadelphia, Wilmington & Baltimore Railroad Co. v. John Dubois*, 12 Wall. 47, 79 U. S. 265, 268; *Seymour v. Osborne*, 11 Wall. 516, 540, 78 U. S. 33; *Clark v. Bousfield*, 10 Wall. 133, 77 U. S. 862; *Hogg v. Emerson*, 6 How. 437, 483, 484; *Hogg et al. v. Emerson*, 11 How. 587; *Skinner Bros. Belting Co. v. Oil Well Improvement Co.*, 54 F. (2d) 896, C. C. A. 10; *Jones et al. v. General Fireproofing Co.*, 254 F. 97, C. C. A. 6; Cert denied 250 U. S. 643; *Farrington v. Haywood*, 35 F. (2d) 628, C. C. A. 6; *Western Well Works et al. v. Layne & Bowler Corp.*, 276 F. 465, C. C. A. 9; *Montgomery Ward & Co. v. Gibbs*, 27 F. (2d) 466, C. C. A. 4, Cert denied 276 U. S. 630.

An Inventor Is Entitled to All the Inherent Advantages and Uses of His Disclosure in Considering His Patent or Application.

An inventor is entitled to all that his patent fairly covers, even though its complete capacity is not recited in the specification and was unknown to the inventor prior to the patent's issuing. (*Diamond Rubber Company of New York v. Consolidated Rubber Tire Company*, 220 U. S. 428, 436 (1910).)

The *Diamond Rubber Company* case has since been approved and followed in a considerable number of cases in this and other courts.

See: *Enterprise Mfg. Co. v. Shakespeare Co.*, 106 F. (2d) 800, C. C. A. Mich. (1939), Cert. den. 60 S. Ct. 590; *Conover v. Coe*, 99 F. (2d) 377 (1938), 69 App. D. C. 144; *Krupp Nirosa Co. v. Coe*, 96 F. (2d) 1013, 68 App. D. C.

323 (1938); Cert. den. 305 U. S. 602; *Hartford-Empire Co. v. Demuth Glass Works*, 19 F. S. 626, D. C. N. Y. (1937); *Tropic Aire v. Cullen-Thompson Motor Co.*, 107 F. (2d) 671, C. C. A. Colo. (1939); *Dailey v. Lipman, Wolfe & Co.*, 88 F. (2d) 362, C. C. A. Ore. (1937); *Western Electric Co., Inc. v. Wallerstein*, 51 F. (2d) 529, D. C. N. Y. (1931); Mod. on other grounds, 60 F. (2d) 723; *In re Mason*, 94 F. (2d) 220 (1938); 25 C. C. P. A. (Patents) 873; *Brand v. Thomas*, 96 F. (2d) 301 (1938), 25 C. C. P. A. (Patents) 1053; *General Electric Co. v. Amperex Electronic Products*, 15 F. S. 438, D. C. N. Y. (1936), Aff'd 89 F. (2d) 709, C. C. A. (1937), Cert. den. 302 U. S. 734; *Minneapolis, St. P. & S. S. M. Ry. Co. v. Barnett & Record Co.*, 257 F. 302, C. C. A. Minn. (1919); *In re Thuau*, 135 F. (2d) 344, C. C. P. A. (1943); *In re Lindemann*, 135 F. (2d) 219, C. C. P. A. (1943); *Smith v. Prutton*, 127 F. (2d) 79, C. C. A. Ohio (1942); *Bailey v. Sears, Roebuck & Co.*, 115 F. (2d) 904, C. C. A. Ore. (1940); Cert. den. 314 U. S. 616; *Sewall v. Jones*, 91 U. S. 171 (1875); *Radio Corp. of America v. Radio Engineering Laboratories*, 293 U. S. 1; 54 S. Ct. 752 (1934).

LOWER COURT'S OPINION.

While, Mr. Associate Justice Arnold, in his opinion, concurred in by the other members of the lower court, concedes that this court in the *Paper Bag Case* reaffirmed the doctrine, that non-use did not invalidate a patent, he says (R. 145):

“We do not follow the reasoning of the *Paper Bag case* because we believe that its principle, which is inconsistent with the constitutional provision that the patent law ‘promote science and the useful arts,’ has been overruled by subsequent decisions.”

Taking up now Justice Arnold's contention that the principle of the *Paper Bag Case* has been overruled by subse-

quent decisions, we find that he relies on the decisions of this Court in *Motion Picture Patents Co. v. Universal Film Mfg. Co.*, 243 U. S. 502 and the *Ethyl Gasoline Case*, 309 U. S. 436.

We have been unable to find the slightest suggestion in either, that non-use, whether deliberate or otherwise, was a defense to the granting of a patent, or to its invalidity after granting. The situation and facts in both cases, were entirely foreign to the situation in the *Paper Bag Case*. The question in the *Paper Bag Case* was whether the owner should be denied an injunction in a suit for infringement, in a court of equity, because he had deliberately and intentionally withheld the use of the Liddell patent on a paper bag making machine, as he had another patent different from Liddell, which he was commercially using in making paper bags.

This court there, not only reaffirmed the recognized rule that mere non-use, even intentional, throughout the life of the patent, was not sufficient to invalidate the patent in a suit for infringement, but also held that such non-use was not even sufficient grounds for denying an injunction in a court of equity.

In the *Motion Picture Case*, plaintiff was seeking to prevent the use of a patented machine, namely, a projector, unless the purchaser used therein certain material—motion picture film—on which the patent had expired. It was also seeking to so limit the use of the projector by attaching a notice to the effect that the use of the machine was limited as to the terms *fixed after sale*.

This court denied plaintiff relief under such circumstances. The whole decision in the *Motion Picture Case* can be searched in vain without finding anything which, directly or by inference, even remotely overrules or impairs this court's decision in the *Paper Bag Case*. On the contrary it

is more proper to say this court *reaffirmed* the rule, for near the bottom of page 514, Mr. Justice Clark, speaking for the majority, said:

“While it is true that under the statutes as they were (and now are) a patentee might withhold his patented machine from public use, * * *”

Moreover, Mr. Justice Holmes, in his dissenting opinion, concurred in by Mr. Justice McKenna and Mr. Justice Van Devanter, said at page 519:

“I suppose that a patentee has no less property in his patented machine than any other owner, and that in addition to keeping the machine to himself the patent gives him the further right to forbid the rest of the world from making others like it. In short, for whatever motive, he may keep his device wholly out of use. *Continental Paper Bag Co. v. Eastern Paper Bag Co.*, 210 U. S. 405, 422. So much being undisputed, * * *.”

In the *Ethyl Gasoline Case*, the government brought suit to restrict the Ethyl Gasoline Corporation and its officers, from granting patent licenses to jobbers to sell and distribute lead-treated motor fuel, and from incorporating provisions in licenses to oil refiners, which restrict their sale of the motor fuel to the licensed jobbers, as violations of the Sherman Anti-Trust Act.

The important facts there were these: The Ethyl Corporation owned two patents covering the composition generally known as ethyl; one patent issued in 1926 and the other in 1928. It also had a third patent, issued before either of these, covering motor fuel produced by mixing ethyl with gasoline. It also had a fourth patent, issued several years after the first three, covering a method for using ethyl in internal combustion motors. The corporation made and sold ethyl to refineries solely for mixing with gasoline and

granted royalty free licenses to them, which licenses prohibited the licensees, from selling the mixture except to jobbers licensed by the Ethyl Corporation. The licenses also contained many other conditions which the refineries agreed to impose on all their customers, and further, agreed to discontinue sale to any jobber whose license the Ethyl Corporation might cancel. The license also fixed the prices and contained conditions as to the use of the Ethyl Corporation's trademark. The license to the jobbers permitted them to sell and deliver to retail dealers within a specified territory, gasoline manufactured by a *designated licensed refiner*. They licensed all leading refineries except one and 11,000 jobbers out of approximately 12,000 in the United States. This court found, as disclosed by the opinion, that the contracts were in violation of the Sherman Act, and the point was conceded, unless the use of the patents saved the situation. The court thereupon proceeded to discuss the situation under the heading "Scope of the Patent Monopoly". At the outset it reaffirmed the rule that a patent confers "the right or power to *exclude* all others from manufacturing, using, or selling his invention" and that the extent of that right was limited by the definition of his invention as its boundaries are marked by the claims of the patent (citing the *Motion Picture Patents Case*), and then went on to say that the patentee could not, by virtue of his patent, condition his license so as to tie to the use of the patented device or process the use of other devices, processes or materials which lie *outside* the licensed patent, or condition the license so as to control conduct by the licensee *not embraced* in the patent. The court then said (page 457):

"By its sales to refiners it relinquishes its exclusive right to use the patented fluid (ethyl); and it relinquishes to the licensed jobbers its exclusive rights to sell the lead-treated fuel (gasoline) by permitting the licensed refiners to manufacture and sell the fuel (gas-

oline) to them. And by the authorized sales of the fuel (gasoline) by refiners to jobbers the patent monopoly over it is exhausted, and after the sale neither appellant nor the refiners may longer rely on the patents to exercise any control over the price at which the fuel (gasoline) may be resold."

The court concluded its observations on page 459 as follows:

"Appellant neither owns nor sells the patented fuel (gasoline) nor derives any profit through royalties or otherwise from its sale. It has chosen to exploit its patents by manufacturing the fluid (ethyl) covered by them and by selling that fluid (ethyl) to refiners for use in the manufacture of motor fuel (gasoline). Such benefits as result from control over the marketing of the treated fuel (gasoline) by the jobbers accrue primarily to the refiners and indirectly to appellant, only in the employment of its monopoly of the fluid (ethyl) secured under another patent. The licensing conditions are thus not used as a means of stimulating the commercial development and financial returns of the patented invention which is licensed, but for the commercial development of the business of the refiners and the exploitation of a second patent monopoly *not embraced in the first*. (Italics ours.) The patent monopoly of one invention may no more be enlarged for the exploitation of a monopoly of another, . . . than for the exploitation of an unpatented article (citing cases), or for the exploitation or promotion of a business not embraced within the patent. (Citing cases)."

Thus it seems clear that this court in the *Ethyl Case* did not have before it and did not pass on, directly or indirectly, the question of whether or not mere non-use, intentional or otherwise, was a bar to the grant of a patent or a bar to its validity after granting, but was dealing with a situation involving a series of contracts which violated the Sherman Anti-Trust Act, and one where a patent was

actually being used, in the exploitation of a monopoly of a second patent "not embraced in the first". Nowhere throughout the sixteen page opinion does the court refer specifically to the *Paper Bag Case*, but it does approve the rule that a patent confers the right to exclude all others from manufacturing, selling or using.

Therefore, for anyone to say there is anything contained in the decisions of this court in either the *Motion Picture* or the *Ethyl Gasoline Cases* which in anywise overrules or impairs the decision of this court in the *Paper Bag Case* is like the, long lost and thirsty, traveler, on the desert, thinking he saw water, when as a matter of fact it was but a mirage.

Associate Justice Arnold in the opinion below, while recognizing at the outset that the inventions disclosed by Ewald, are novel, of tremendous importance, and have revolutionized the pear canning industry; that his generic invention without the knife produced a useful result, and that "two distinctive inventions are disclosed in the applications", mistakenly says that a "patent has been allowed on the claims on the entire machine." This is a factual error. No patent has been allowed on the entire machine. Claims have been found allowable, but no patent has issued on this application.

Near the bottom of the second page of his opinion (R. 153) Justice Arnold quotes from a program of some undisclosed, large concern, in nowise connected with this suit or with petitioner. He refers to it as a blocking or fencing patent program, and apparently attempts to inject into this case what some undisclosed stranger has done in relation to its patent program. We do not question, that Justice Arnold's statement, as to what this undisclosed stranger said or did regarding its patent program, is correct, but there is no reason why petitioner here should be penalized and denied claims on Ewald's main invention because of

something this undisclosed stranger did, or because other strangers have violated the Sherman Anti-Trust Act by wrongfully using patents to control unpatented materials or products. We have no doubt that here and there, as evidenced by the prior decisions of this court, owners of patents have been guilty of such misconduct as to disentitle them to relief in a court of equity. This is *not* one of those cases.

As Judge Evans of the Seventh Circuit well said, in his Foreword to Barnett's "Patent Property and Anti-Monopoly Laws", published in 1943, in referring to such misconduct of certain owners of patents:

"* * * the assault on the entire patent system, which, system has aroused such justifiable pride by all of us, and which has been the source of much of our commercial development, as well as the appearance of tens of thousands of products which have made living for all, more happy and desirable, is as unwise as the dairyman to kill his herd because one cow was a fence creeper or a fence jumper."

We should not confound the granting of patents, or the innocent acquirement of property, with the prevention of the unlawful use of patents or property. It is difficult to imagine anything, which has not been used unlawfully. There are those, in nearly every walk of life who *misuse* their license, power, authority, or property, but that is no reason why their *misuse* should be imposed on the innocent and guilty alike.

Justice Miller's opinion, in which Justice Arnold concurred, found and held that the claims in question were typical subcombination claims; that there was no lack of completeness or clarity in them; that they specifically point out what was claimed as an invention; that it would not be difficult to construct the subcombination from the drawings; that the notion that the bobbing operation cannot take place

after the pear has been split by hand ignores the texture and character of canning pears; that the suggestion that the combination is inoperative when the pear is pre-split by hand is directly contrary to the evidence, particularly to the incontrovertible evidence of the motion picture which was displayed to the court; that the notion that the inventor must have thought only in terms of splitting as an intermediate process ignores the long history of pear canning as a hand process, and the inescapable fact that one who was experimenting in this area must have tried a variety of arrangements until he found the one most adapted to his purpose; that considered in terms of the older practices in pear canning, this subcombination machine standing alone represented a tremendous advance, and, in operation, would result in great saving of manpower, of time, of working space; and that the record makes these facts apparent beyond question, thus clearly overruling the grounds relied on by the district court and the Patent Office, in denying relief.

Justice Miller then says that the claims in question were filed by the inventor's assignee seven years after the original application (R. 148); and that where claims are filed by assignees, who are manufacturers and distributors rather than persons skilled in the art, the Patent Office is put on notice.

Now the fact, unquestionably established by the record, is that Ewald himself, an independent inventor and independent businessman, in a little town in Washington, when he originally filed his application on October 6, 1932, presented, *under oath*, as his first claim (R. 80) a generic claim to his main invention *which did not include the splitting knife*. Thus the foundation for Justice Miller's contention is completely wiped out. The assignee mentioned happens to be Ewald's small company of which he was, "manager and president" (R. 15). Moreover, the claims in question

were actually presented by the independent inventor and businessman Ewald, who filed this suit and the identical claims were made a part of his bill. It was long after the suit was brought, that his company was substituted as plaintiff.

Justice Miller further concedes, near the end of his opinion, that "Here the subcombination claims, standing alone, describe a useful machine." Then he says, "Frank admission of intention to suppress the subcombination for the purpose of protecting the *main invention* completes the picture." Again we find the court is in error as to the facts. No admission was or could have been made of intention to suppress the *main invention* or "subcombination" because, the record shows *beyond all doubt* that the subcombination, which is the main invention, *was necessarily used extensively in every machine*, put out by Ewald, or his company. In fact, as shown by the evidence, eighty per cent of the pears canned in this country were bobbed, peeled and cored with what the court terms the subcombination. It is true that in commercial practice the knife was added for handling pears, when not pre-split, *but in every one of those machines, the subcombination was necessarily used and constituted the main part of the machine and the main invention*. Therefore there cannot possibly be in this suit any question of *suppression* of the main invention.

Lack of intention to use, is at most, if carried out, no use at all. In the *Motion Picture Case* the plaintiff was *actually using* its patents in an attempt to prevent the use of unpatented material not covered by the patent and in the *Ethyl Case* the owner of the patent was actually using a patent to exploit or control a second patent "*not embraced in the first*" and which he himself had released. In both cases, *actual* improper use was made of a patent. The cases were not based on a mere intention to do an act, but the unlawful thing was actually done and clearly proven.

CONCLUSION.

It is crystal clear, from the evidence and the opinion of the appellate court, that the claims here sought are directed to Ewald's main invention which is generic and revolutionary in character; that it has been used extensively by the pear canning industry; that pears have been bobbed, peeled and cored for canning by utilizing this generic invention on which was superimposed a splitting knife; that the generic invention *sans* knife was successfully demonstrated by feeding pre-split pears and proved a tremendous advance over all prior equipment and methods; that it is generally known and understood in the art, prior to the advent of Ewald's invention, that pears were pre-split by hand or otherwise; that the Ewald invention can be successfully operated when handling either whole or pre-split pears, and when run on the latter, the splitting knife is wholly unnecessary and may be removed; that Ewald, the independent inventor and businessman, when filing his original application presented, under oath, as his first claim, one directed to his *main invention* which did not include the splitting knife; that there is no lack of intention to use the main invention and cannot be, for the record conclusively shows that the main invention covered by the claims in controversy was *actually extensively used*; that the mere fact that the inventor or the patentee has been using the main invention thus far in commercial work in connection with an additional thing, viz., the splitting knife, and may or may not intend in the future to use his main invention with an additional thing, such as the splitting knife, does not under the law constitute a misuse or create any legal ground for denying a claim or claims on the main invention; that under the Constitution and the Statutes and the cases applicable, a patentee receives no right or license to *actually* manufacture, sell or use the claimed invention, but *only to ex-*

clude; that a patentee is entitled to ~~receive~~ in the same patent, not only claims on his main invention, but on combinations and parts thereof which are patentably novel; that a subcombination need not be useful in itself; and that an applicant or patentee is entitled to all the capacities and uses of his devices, whether recited in the specification or known to the inventor prior to the patent's issuing, and need not, under the law, disclose, or even anticipate the uses of his invention.

It is also clear that the court of appeals overruled the grounds relied on by the district court, and the Patent Office, in denying relief, but notwithstanding, it rejected the claims solely on lack of intention to use *alone*.

The decisions of this court in the *Motion Picture* and *Ethyl Gasoline Cases* do not overrule directly or by implication the doctrine long established and reaffirmed in the *Paper Bag Case* to the effect that intentional non-use even during the entire life of the patent does not invalidate the patent; on the contrary, this rule was recognized and approved in the *Motion Picture Case*, not only in the opinion of the majority, but also in the dissenting opinion of the minority, and has been reaffirmed or approved or recognized since.

If patent claims are to be denied an independent inventor, on his *main invention*, because he has not used it commercially *alone* or, may not intend so to do, there are few of us, who would care to imagine, what will happen to our industrial civilization.

The decision of the Court of Appeals, involving a question of tremendous importance to the public, is in direct conflict with the decisions of this, and other courts, and substantially impairs our patent system, the *basis of our in-*

strial civilization. For this and other reasons set forth
rein, it should be reversed with directions to allow the
aims here sought on the independent inventor's main in-
vention.

Respectfully submitted,

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J. L.

ated: January 2, 1945.

APPENDIX.**STATUTES ON JURISDICTION.**

Sec. 4915 R. S., (U. S. C., title 35, sec. 63) (Amended by Act of February 9, 1893, c. 74, sec. 9, 27 Stat. 436; March 2, 1927, c. 273, sec. 11, 44 Stat. 1336; March 2, 1929, c. 488, sec. 2 (b), 45 Stat. 476; August 5, 1939, c. 451, sec. 4, 53 Stat. 1212.)

Whenever a patent on application is refused by the Board of Appeals or whenever any applicant is dissatisfied with the decision of the board of interference examiners, the applicant, unless appeal has been taken to the United States Court of Customs and Patent Appeals, and such appeal is pending or has been decided, in which case no action may be brought under this section, may have remedy by bill in equity, if filed within six months after such refusal or decision; and the court having cognizance thereof, on notice to adverse parties and other due proceedings had, may adjudge that such applicant is entitled, according to law, to receive a patent for his invention, as specified in his claim or for any part thereof, as the facts in the case may appear. And such adjudication, if it be in favor of the right of the applicant, shall authorize the commissioner to issue such patent on the applicant filing in the Patent Office a copy of the adjudication and otherwise complying with the requirements of law. In all cases where there is no opposing party a copy of the bill shall be served on the commissioner; and all the expenses of the proceedings shall be paid by the applicant, whether the final decision is in his favor or not. In all suits brought hereunder where there are adverse parties the record in the Patent Office shall be admitted in whole or in part, on motion of either party, subject to such terms and conditions as to costs, expenses, and the further cross-examination of the witnesses as the court may impose, without prejudice, however, to the right of the parties to take further testimony. The testimony and exhibits, or parts thereof, of the record

in the Patent Office when admitted shall have the same force and effect as if originally taken and produced in the suit.

Act of Mar. 3, 1911, c. 231, sec. 24, 36 Stat. 1091 (Judicial Code):

Sec. 24. (U. S. C., title 28, sec. 41.) The district courts shall have original jurisdiction as follows:

• • • • • •

Seventh. Of all suits at law or in equity arising under the patent, the copyright, and the trade-mark laws.

The District Court of the United States for the District of Columbia (formerly the Supreme Court of the District of Columbia) in patent causes has district court jurisdiction—Cochrane v. Deener, 94 U. S. 780; 11 O. G. 687.

Sec. 128. (U. S. C., title 28, sec. 225.) (a) The circuit court of appeals shall have appellate jurisdiction to review by appeal final decisions—(Amended by act of Feb. 13, 1925.)

First. In the district courts, in all cases save where a direct review of the decision may be had in the Supreme Court under section two hundred and thirty-eight. (U. S. C., title 28, sec. 345.)

STATUTES INVOLVED.

Section 4884 R. S. (U. S. C., title 35, sec. 40.) Every patent shall contain a short title or description of the invention or discovery, correctly indicating its nature and design, and a grant to the patentee, his heirs or assigns, for the term of seventeen years, of the exclusive right to make, use and vend the invention or discovery (including in the case of a plant patent the exclusive right to asexually reproduce the plant) throughout the United States and the Territories thereof, referring to the specification for the particulars thereof. A copy of the specification and drawings shall be annexed to the patent and be a part thereof.

Section 4886 R. S., (U. S. C., title 35, sec. 31.) (Amended by Act of March 3, 1897, c. 391, sec. 1, 29 Stat. 692; Act of March 23, 1930, c. 312, section 1, 46 Stat. 376) Any person who has invented or discovered any new and useful art, machine, manufacture, or composition of matter, or any new and useful improvements thereof, or who has invented or discovered and asexually reproduced any distinct and new variety of plant, other than a tuber-propagated plant, not known or used by others in this country, before his invention or discovery thereof, and not patented or described in any printed publication in this or any foreign country, before his invention or discovery thereof or more than two years prior to his application, and not in public use or on sale in this country for more than two years prior to his application, unless the same is proved to have been abandoned, may, upon payment of the fees required by law, and other due proceeding had, obtain a patent therefor.

Act of August 5, 1939, c. 450, 53 Stat. 1212:

That sections 4886, 4887, 4920, and 4929 of the Revised Statutes (U. S. C., title 35, secs. 31, 32, 69, and 73) be amended by striking out the words "two years" wherever they appear in said sections and substituting therefor the words "one year."

Sec. 2. This Act shall take effect one year after its approval and shall apply to all applications for patent filed after it takes effect and to all patents granted on such applications: *Provided, however,* That all applications for patents filed prior to the time this Act takes effect and all patents granted on such applications are to be governed by the statutes in force at the time of approval of this Act as if such statutes had not been amended.

Section 4888 R. S., (U. S. C., title 35, sec. 33) (Amended by Act of March 3, 1915, c. 94, sec. 1, 38 Stat. 958; Act of May 23, 1930, c. 312, sec. 2, 46 Stat. 376:

Before any inventor or discoverer shall receive a patent for his invention or discovery he shall make application therefor, in writing, to the Commissioner of Patents, and shall file in the Patent Office a written de-

scription of the same, and of the manner and process of making, constructing, compounding, and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art or science to which it appertains, or with which it is most nearly connected, to make, construct, compound, and use the same; and in case of a machine, he shall explain the principle thereof, and the best mode in which he has contemplated applying that principle, so as to distinguish it from other inventions; and he shall particularly point out and distinctly claim the part, improvement, or combination which he claims as his invention or discovery. The specification and claim shall be signed by the inventor. No plant patent shall be declared invalid on the ground of noncompliance with this section if the description is made as complete as is reasonably possible.

CONSTITUTION.

Article I.

Section 8. The Congress shall have Power, . . .

To promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries.

ILLUSTRATIVE DRAWING EMBODYING EWALD INVENTION

